

REMARKS

Claims 1-24 are pending in the application.

Rejection under 35 U.S.C. § 103(a)

In an Office Action dated November 1, 2005, the Examiner rejected claims 5-8 and 21 under 35 U.S.C. § 103(a) as allegedly obvious over Deshpande et al., "Biphasic catalysis for a selective oxo-Mannich tandem synthesis of methacrolein," *Journal of Molecular Catalysis A: Chemical*, 211(1-2):49-53 (2004) ("Deshpande"). The Examiner indicated in a telephone call to Applicants' representative on September 30, 2005 that, since an applicant's disclosure of his own work within the year before the application filing date cannot be used against him as prior art, Deshpande could be overcome if the Applicants filed an *In re Katz* declaration. *In re Katz*, 687 F.2d 450 (C.C.P.A. 1982). The declaration must set forth the nature of the work performed on the project by A.N. Mahajan, who is listed as a co-author of Deshpande, but is not a co-inventor of the instant application.

As indicated by the Examiner in the Office Communication mailed June 21, 2006, the Applicants' *bona fide* reply to the Office Action dated November 1, 2005 did not include an *In re Katz* Declaration. As of May 1, 2006, the final date for responding to the November 1, 2005 Office Action, the Applicants' representative was still in the process of obtaining the information necessary to prepare the declaration.

Accordingly, a Declaration of Raj M. Deshpande, Makarand M. Diwakar and Raghunath V. Chaudhari Under 37 CFR §1.132 and In Accordance With *In Re Katz* is submitted concurrently herewith. This Declaration has been executed by each of the inventors of the claimed subject matter in the instant application, all of whom are co-authors of Deshpande.

The *In re Katz* Declaration establishes that A.N. Mahajan, the other co-author of the Deshpande reference, is not a co-inventor of the subject matter described and claimed in the instant application. *In re Katz* Declaration at ¶6. Rather, the claimed process of preparing alpha-substituted

acroleins was conceived, developed and invented by Raj M. Deshpande, Makarand M. Diwakar and Raghunath V. Chaudhari only. *In re Katz* Declaration at ¶7. Co-author A.N. Mahajan merely provided analytical input into the Deshpande publication and did not contribute to the actual research. A.N. Mahajan did not contribute to the conception of the instant invention.

Accordingly, the Deshpande publication cannot be used as prior art against the instant application. *In re Katz*, 687, F.2d 450, 215 USPQ 14 (CCPA 1982). Applicants respectfully request, therefore, that the rejection under 35 U.S.C. §103(a) be withdrawn.

Conclusion

In view of the declaration and the above remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

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Respectfully submitted,

Bv

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